

Serial No. 09/996,641
Filed: November 28, 2001
Response to Office Action

REMARKS

With entry of the present amendment claims 2, 5, 6, 11, 13, 19, and 32 are pending. Claims 1, 3, 4, 7 to 10, 12, 14 to 18, and 20 to 31, have been cancelled, and new claim 32 has been added. Claims 2, 5, 6, 11, and 13 have been amended as required by the Examiner. No new matter has been added by these amendments.

No additional fees are believed due. However, the Director is hereby authorized to charge any deficit, or credit any overpayment, to Deposit Account No. 08-2525.

RESTRICTION REQUIREMENT

The claims were previously restricted to the following four groups.

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|-----------|---|
| Group I | Claims 10, 11 and 13-20, drawn to compounds and pharmaceutical compositions of compounds of Formula I-A. |
| Group I | Claims 10, 12, 21, and 24-26, drawn to compounds and pharmaceutical compositions of compounds of Formula I-B. |
| Group III | Claims 10, 27, 30 and 31, drawn to compounds and pharmaceutical compositions of compounds of Formula I-B-2. |
| Group IV | Claims 1-9, 22, 23, 28 and 29, directed to methods. |

A requirement also was made for the election of a single disclosed species.

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In response to the restriction requirement, Applicants elected, with traverse, Group I, compounds of Formula I-A. Applicants further elected the species 3-phenethynyl-4H-5-oxa-2,9b-diazacyclophena[a]naphthalene. The restriction requirement has been made final.

METHOD CLAIMS

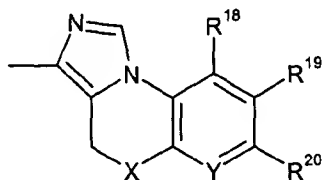
M.P.E.P. § 821.04 provides for rejoinder of product and process claims that have been restricted. Where claims directed to a product and related process are restricted, the product claims elected, and the product claims found allowable, section 821.04 requires rejoinder of the process claims having all of the limitations of the allowable product claim.

As discussed below, the compound claims in the instant application have been amended to recite the scope indicated as allowable by the Examiner. The method claims also have been amended to recite the scope of the allowable compound claims. New claim 32, directed to a method of making the claimed compounds, has been added. This claim also corresponds in scope to the allowable compound claims. Applicants hereby request rejoinder of the method claims in accordance with M.P.E.P. § 821.04.

CLAIM OBJECTION

The Office Action states that the Patent Office has created a generic concept including the elected compound. The generic concept created by the Patent Office is the compound of Formula I-A in which R^1 to R^5 are independently selected from hydrogen, lower alkyl, $-(CH_2)_n$ -halogen, lower alkoxy, $-(CH_2)_n$ -NRR', $-(CH_2)_n$ -N(R)-C(O)-lower alkyl, or aryl; R and R' are independently hydrogen and lower alkyl; and B is the structure

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in which R¹⁸ to R²⁰ are independently hydrogen, lower alkyl, -(CH₂)_n-halogen or lower alkoxy; X is O or S; and Y is CH= or N=. The subject matter related to Groups II and III, above, and subject matter alleged not to read on the elected species were withdrawn from consideration.

In the pending Office Action, no rejection of the claims on the merits has been made. Claims 10, 11, and 13 to 30 have been objected to, however, as containing non-elected subject matter. Solely to advance prosecution, applicants have amended the claims to conform to the scope indicated as allowable by the Examiner. However, applicants reserve the right to pursue the canceled subject matter in divisional applications.

Applicants traverse the objection made by the Examiner and submit that the objection is an improper refusal of the Patent and Trademark Office to examine applicants' claimed invention. In particular, the claim objection is contrary to the courts decision in *In re Weber*, 198 U.S.P.Q. 328 (CCPA 1978), 37 C.F.R. § 1.141, and the procedures for search and examination of Markush-type claims set forth in M.P.E.P. § 803.02.

By statute, an applicant has the right to claim his invention with limitations he regards as necessary to circumscribe that invention, so long as the requirements of 35 U.S.C. § 112 are met. *In re Weber*, 198 U.S.P.Q. at 331, citing *In re Wolfram*, 179 U.S.P.Q. 620 (CCPA 1973). No rejection under 35 U.S.C. § 112 was made in the instant application. Thus, applicants have the right to claim their invention as they contemplate it and to have that invention examined in its entirety.

Further, applicant has a right to have each claim examined on the merits. The court in *In re Weber* held that the Patent Office must examine a claim on its merits and cannot refuse to examine subject matter within a single claim because such a refusal violates applicant's right to have that claim examined on the merits. In support of its holding, the court determined that if the Patent Office required a single claim to be divided and presented in several applications, the claim would never be considered on its merits. In particular, the court found that the totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim and that because the subgenera would be defined by the examiner rather than by the applicant, some of the fragments may not be described in the specification. The court further weighed the right of the Commissioner to divide applications for administrative and search purposes against applicant's right to have his invention examined and held that applicant's rights are paramount. *In re Weber*, 198 U.S.P.Q. at 331-32.

Applicants submit that the Patent Office's objection in the instant application is a refusal to examine applicant's claimed invention and that this refusal is not only contrary to the court's decision in *In re Weber*, but also is contrary to the regulations, practices, and procedures established by the Patent Office for examination of generic Markush claims. In particular, refusal to examine applicants' claims is in violation of 37 C.F.R. § 1.141 and the procedures prescribed in M.P.E.P. § 803.02.

37 C.F.R. § 1.141 provides for the inclusion of two or more independent and distinct inventions in an application where the claims are directed to species of an invention, provided that the application also includes an allowable claim generic to all of the claimed species. The procedure for examining such generic claims is set forth in M.P.E.P. § 803.02. This section provides for election of a single disclosed species where the application contains a Markush claim. Section 803.02 also provides that if no prior art is found that anticipates or renders obvious the elected species, the search and

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examination of the Markush claim will be extended to the extent necessary to determine patentability of the Markush-type claim.

In the instant application, this procedure was not followed. Rather, claims 10, 11, and 13 to 20 were divided into three separate groupings. Applicants submit that the Patent Office's division of a single claim into multiple groups and its refusal to examine the additional portions of the claim in the present application is contrary to the procedure provided in M.P.E.P. § 803.02. In particular, division of the claims into separate groups denies applicants the right to have the search and examination of the generic claim extended to the extent necessary to determine its patentability.

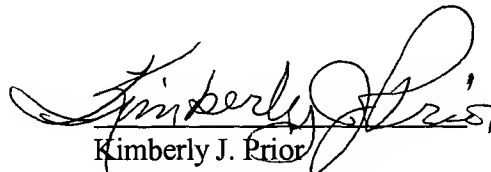
To the extent that the Patent Office followed the procedure set forth in the M.P.E.P. § 803.02 by requiring election of a single disclosed species, applicants traverse the claim objection because the search and examination of the claim has not been extended. No art rejection has been made. In the absence of prior art, M.P.E.P. § 803.02 requires extension of the search and examination of the generic claim to the extent necessary to determine its patentability. Applicants assert that it is improper, in the absence of an art rejection, for the Patent Office to refuse to examine applicants' claims.

The foregoing amendment is fully responsive to the Office Action issued March 21, 2003. Applicants submit that Claims 2, 5, 6, 11, 13, 19, and 32 are in condition for allowance. Early and favorable consideration is earnestly solicited.

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If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kimberly J. Prior", is written over a horizontal line.

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